



PTO/SB/21 (09-04)

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Total Number of Pages in This Submission

|                        |                     |
|------------------------|---------------------|
| Application Number     | 10/807,612          |
| Filing Date            | March 23, 2004      |
| First Named Inventor   | Liu, Hong           |
| Art Unit               | 1621                |
| Examiner Name          | Peter G. O'Sullivan |
| Attorney Docket Number | 021288-002610US     |

**ENCLOSURES (Check all that apply)**

- |  |   |  |
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| <input type="checkbox"/> Fee Transmittal Form<br><input type="checkbox"/> Fee Attached<br><input type="checkbox"/> Amendment/Reply<br><input type="checkbox"/> After Final<br><input type="checkbox"/> Affidavits/declaration(s)<br><input type="checkbox"/> Extension of Time Request<br><input type="checkbox"/> Express Abandonment Request<br><input type="checkbox"/> Information Disclosure Statement<br><br><input type="checkbox"/> Certified Copy of Priority Document(s)<br><input type="checkbox"/> Reply to Missing Parts/ Incomplete Application<br><input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53 | <input type="checkbox"/> Drawing(s)<br><input type="checkbox"/> Licensing-related Papers<br><input type="checkbox"/> Petition<br><input type="checkbox"/> Petition to Convert to a Provisional Application<br><input type="checkbox"/> Power of Attorney, Revocation<br>Change of Correspondence Address<br><input type="checkbox"/> Terminal Disclaimer<br><input type="checkbox"/> Request for Refund<br><input type="checkbox"/> CD, Number of CD(s) _____<br><input type="checkbox"/> Landscape Table on CD | <input type="checkbox"/> After Allowance Communication to TC<br><input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences<br><input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)<br><input type="checkbox"/> Proprietary Information<br><input type="checkbox"/> Status Letter<br><input checked="" type="checkbox"/> Other Enclosure(s) (please identify below):<br>RESPONSE TO ELECTION; Return Postcard |
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| Remarks | The Commissioner is authorized to charge any additional fees to Deposit Account 20-1430. |
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**SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT**

|              |                                    |
|--------------|------------------------------------|
| Firm Name    | Townsend and Townsend and Crew LLP |
| Signature    |                                    |
| Printed name | Joseph R. Snyder                   |
| Date         | January 14, 2005                   |

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| Reg. No. | 39,381 |
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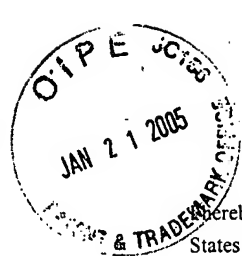
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TOWNSEND and TOWNSEND and CREW LLP

By:

*Julia Costa*

PATENT

Attorney Docket No.: 021288-002610US  
Client Ref. No.: P1086US10.

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of:

Hong Liu, *et al.*

Application No.: 10/807,612

Filed: March 23, 2004

For: INHIBITORS OF CATHEPSIN S

Customer No.: 20350

Confirmation No. 4266

Examiner: Peter G. O'Sullivan

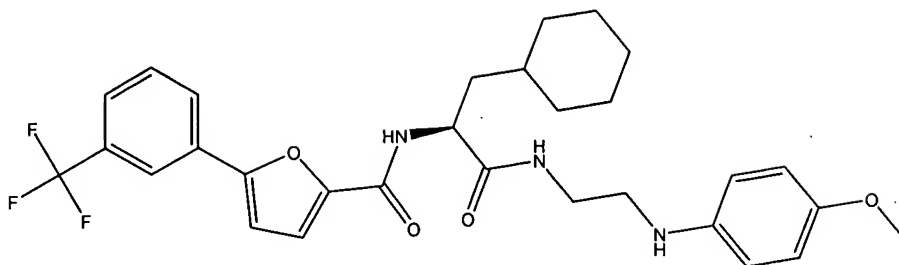
Technology Center/Art Unit: 1621

RESPONSE TO ELECTION

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In the Election of Species Requirement mailed December 14, 2004, the Examiner has indicated that an election to a single disclosed species is necessary under 35 U.S.C. § 121. For the record, Applicants' representative left a message on the Examiner's telephone on December 9, 2004, electing the compound disclosed in Example 117, with traverse. The chemical structure of the compound set forth in Example 117, namely: (S)-5-(3-Trifluoromethyl-phenyl)-furan-2-carboxylic acid {2-cyclohexyl-1-[2-(4-methoxy-phenylamino)-ethylcarbamoyl]-ethyl}-amide, is reproduced below for the Examiner's convenience.



Claims readable thereon include claims 1-2 and 8-19, wherein W is  $R^1-X-(C=O)-NH-CHR^2-$ . The foregoing election and restriction requirement is respectfully traversed.

In the presently *mailed restriction requirement*, Applicants note that individual inventions are not delineated. This in contrast to the telephone restriction requirement of December 7, 2004 with the undersigned representative, wherein Claim 1 was separated into Groups I-VI. Applicants therefore assume that the Examiner has realized that the telephone restriction requirement was *improper* and therefore has *withdrawn* the restriction requirement.

As the telephone restriction requirement split a single claim into multiple groups, the restriction requirement was improper as a matter of law. The courts have long held that the section of the patent statute that authorizes restriction practice, *i.e.*, 35 U.S.C. § 121, provides no legal authority to impose a rejection on a single claim, even if the claim presents multiple independently patentable inventions. See, *In re Weber*, 198 USPQ 328, 331 (CCPA 1978); *In re Haas*, 179 USPQ 623, 624-625 (*In re Haas I*) (CCPA 1973) and *In re Haas* 198 USPQ 334-337 (*In re Haas II*) (CCPA 1978). As stated in *In re Weber*:

[t]he discretionary power to limit one applicant to one invention is no excuse at all for refusing to examine a broad generic claim—no matter how broad, which means no matter how many independently patentable inventions may fall within it. 198 USPQ 328 at 334.

In a case such as the instant case, where a claim is generic, a restriction requirement is tantamount to a rejection of the claim. The CCPA made this point very clear in *In re Haas I*:

[w]e find that the action taken by the examiner did in fact amount to a rejection. . . . Those claims were withdrawn from consideration not only in this application but prospectively in any subsequent application

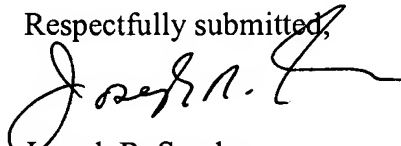
because of their content. In effect there had been a denial of patentability of the claims. Presumably only by dividing the subject matter into separate, and thus different, claims in plural applications could an examination of the patentability of their subject matter be obtained. 179 USPQ at 625.

As the Examiner must have realized, if the telephone restriction requirement was allowed to stand, Applicants would never be accorded "the basic right of the applicant to claim his invention as he chooses." *In re Weber*, 198 USPQ at 331. In *In re Weber*, the CCPA stated that "[a]s a general proposition, an applicant has a right to have *each* claim examined on the merits" (198 USPQ at 331, emphasis in original). The Court went on to state that:

[i]f . . . a single claim is required to be divided up and presented in different applications, that claim would never be considered on its merits. The totality of the resulting fragmentary claims would not necessarily be the equivalent of the original claim. Further, since the subgenera would be defined by the examiner rather than by the applicant, it is not inconceivable that a number of the fragments would not be described in the specification." 198 USPQ at 331.

In view of the foregoing, Applicants respectfully request that the Examiner make clear that the restriction requirement has been withdrawn. Further, early action on the merits is respectfully requested. If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 925-472-5000.

Respectfully submitted,



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